

II. Rejection Under 35 U.S.C. § 103

The Examiner rejects pending claims 1-3, 5-12, 16-26, 50, and 53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,799,456 ("*Dubief*") in view of U.S. Patent No. 5,656,258 ("*Cauwet*") and U.S. Patent No. 5,958,392 ("*Grollier*"). Office Action dated Feb. 24, 2005, at 2. Specifically, the Examiner cites *Dubief* for teaching a composition comprising "ceramide compounds and a cationic polymer." *Id.* The Examiner admits that "*Dubief* does not teach expressly the employment of amphoteric polymer in the composition, or polyquaternium, also known as MERQUAT 280." *Id.* at 2-3. Thus the Examiner relies on *Cauwet* and *Grollier* to cure the deficiencies of *Dubief*.

The Examiner asserts that *Grollier* "teaches the employment of a combination of cationic polymer and amphoteric polymer in hair cosmetic composition. Such combination has overcome many disadvantages of compositions using cationic polymer alone or using other combination." *Id.* at 3 (citing *Grollier* at col. 1, lines 16-59). The Examiner further asserts that *Cauwet* "teaches that polyquaternium-22, or MERQUAT 280 is a known amphoteric copolymer of acrylic acid and dialkylaminoalkyl acrylamide, and is particularly useful in hair treating composition with cation [sic] polymers." *Id.* (citing *Cauwet* at col. 1, line 49 to col. 2, line 65; col. 3, lines 1-38; col. 6, lines 10-28). Thus, the Examiner concludes that "it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the claimed invention was made, to employ a combination of the cation[ic] polymer and the amphoteric polymer herein in *Dubief* composition . . . because of the advantage of the combination of

cation[ic] polymer and amphoteric polymer disclosed by Grollier et al. and Cauwet et al.”

Id. at 3-4.

Applicants respectfully disagree traverse for at least the following reasons.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must at least teach or suggest all of the claim limitations **and** must provide a suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine references. See M.P.E.P. § 2143. Applicants maintain that the Examiner has not established a prima facie showing of obviousness, for at least the reasons we have previously argued, and argue below.

In particular, all three references combined do not teach or suggest all of the present claim limitations. The Examiner has admitted that *Dubief* does not teach polyquaternium-22. *Grollier* also does not teach the use of polyquaternium-22. While *Cauwet* expressly teaches that the weight ratio of its at least one quaternary polyammonium polymer (a) to its at least one polymer (b) containing diallyldialkylammonium units be less than 1. Thus, there is no teaching of at least one amphoteric polymer chosen from polyquaternium-22 wherein the weight ratio of said at least one cationic polymer to said at least one amphoteric polymer is greater than or equal to 3:1. See, e.g., Claim 1.

In response to our previous argument that the references cited do not teach or suggest all of the claim limitations, the Examiner responded that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” Office Action dated Feb. 24, 2005, at 4 (citations omitted).

Applicants respectfully submit to the Examiner that rather than attacking each reference individually, we are explaining how even after combination the references are still missing claimed elements. See e.g., *Cauwet Abstract*.

Further, the Examiner has not shown any suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited references to arrive at the present claims. In particular, the Examiner glosses over the limitation that the weight ratio of said at least one cationic polymer to polyquaternium-22 is greater than or equal to 3:1. The Examiner contends that both *Grollier* and *Cauwet* "teaches [sic] the benefits of the combination of cationic polymer and amphoteric polymers, and both [sic] teach a broad range of the ratio of the polymers." Office Action dated Feb. 24, 2005, at 4. The Examiner concludes it "is well settled that in the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists." *Id.* (citations omitted). Applicants respectfully disagree with the Examiner both factually and legally.

First, the broad range of ratios disclosed in *Grollier* would not teach or suggest to one of ordinary skill in the art that the ratio of cationic polymers to amphoteric polymers is a result-effective parameter, and thus would not provide motivation, especially in combination with *Dubief* and *Cauwet*, to create a composition with the claimed ratio. Moreover, *Grollier's* range is so broad that it is analogous to a genus that does not render the species obvious. See M.P.E.P. § 2144.05(l) (citing *In re Peterson*, 315 F.3d 1325 (Fed. Cir. 2003)). Thus, the Examiner's contention that "it is well settled" that a broad range (e.g., the ratio of 10:1 to 1:10 in *Grollier* claim 16, cited by the Examiner in

Office Action dated Feb. 24, 2005, at 5) encompassing one point (e.g. the claimed ratio 3:1) establishes a *prima facie* showing of obviousness is factually and legally wrong.

See M.P.E.P. § 2144.08(II) (citing *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994)).

Second, this is not a case where the claimed ranges overlap or lie inside the ranges disclosed by the art. Rather, the entire teaching of *Cauwet* is of cationic polymers in combination with at least one amphoteric polymer **in a ratio no greater than 1.5 to 1** and more specifically, where at least one amphoteric polymer is chosen from polyquaternium-22. See, e.g., *Cauwet* abstract. By disclosing such a ratio, *Cauwet* is teaching that the weight content of cationic polymers needs to be **equal to or less than** amphoteric polymers. Thus, *Cauwet* teaches away from the present claims, which require that the weight ratio of the at least one cationic polymer to the at least one amphoteric polymer is greater than or equal to 3:1, i.e, the weight content of cationic polymers is **greater than** amphoteric polymers.

The Examiner attempts to rebut this argument by citing the claim language in *Cauwet*, which is any “synergistic combination” of cationic to amphoteric polymer. The claim language does not change the fact that the specification of *Cauwet* teaches a synergistic combination as a ratio of cationic to amphoteric polymer **no greater than 1.5 to 1**. See *Cauwet* specification at col. 1, lines 49-53 (“It has been discovered that the combination of certain conditioning polymers . . . when they are used in a given ratio make it possible to overcome these disadvantages due to a synergistic effect that is achieved.”). See also *Cauwet* Examples.

The Examiner cannot merely rely on *Cauwet*’s claim language and its teaching of amphoteric polymers, and ignore the amount of amphoteric polymers taught throughout

the specification. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). Moreover, any attempt to cure the teaching away would be fundamentally improper as it would destroy the inventive nature of Cauwet. See *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989) (holding that it is improper to combine references if their combination would result in the destruction of the intended operation or if a reference teaches away from the claimed invention).

Accordingly, one of ordinary skill in the art would not be motivated to combine the teachings of *Dubief*, *Grollier* and *Cauwet* in order to create the presently claimed invention. The Examiner has failed to make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the claimed invention for combination in the manner claimed. See *Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 1998).

Thus, for at least the foregoing reasons, the rejection is improper and Applicants respectfully request that it be withdrawn.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims. The timely allowance of the pending claims is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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